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10/090,517	03/04/2002	Bradley Steven Resch	8866	6459

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/090,517
Filing Date: March 04, 2002
Appellant(s): RESCH ET AL.

Juliet A. Jones
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 29, 2006 appealing from the Office action mailed September 3, 2004.

(1) (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US Patent 6,024,941	Yanagida et al.	February 15, 2000
US Patent 5,939,082	Oblong et al.	August 17, 1999
US Patent 5,821,237	Bissett et al.	October 13, 1998 (9)

Grounds of Rejection

Claims 1-12, 14-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagida et al. (US 6,024,941), in view of Oblong et al. (US 5,939,082) and Bissett et al. (US 5,821,237).

1. Yanagida et al. teaches stable cosmetic compositions wherein vitamin A is stabilized by one stabilizer wherein the stabilizer is selected from a groups of compounds including phenols, vitamin E, C, salicylic acid. The compositions may further comprise EDTA, and other well-known cosmetic ingredients, such as vitamin E, glycerine, polyethylene glycol, polypropylene glycol, fatty acid, and perfume. See, particularly, the abstract, table 1, 6-2; examples 2-5, 3-7, 4-4, 4-7, 5-4, and the claims.
2. Yanagida et al. do not teach expressly to exclude parahydroxybenzoic acid ester, or formaldehyde and formaldehyde donating compounds, or employ particular vitamin A derivatives herein, such as retinyl propionate, or employ particular preservative, such as O-phenylphenol.

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3. However, as shows in the claims and the examples, Yanagida et al. do not require the present of parahydroxybenzoic acid ester, or formaldehyde, or its donating compounds. Oblong teaches that synthetic or natural vitamin analog, such as retinol esters, e.g., retinyl propionate, are well known in the art for use as vitamin A in cosmetic compositions. See, particularly, column 22, lines 26-52. Bissett et al. teaches that the preservatives herein employed, such as O-phenylphenol, dehydroacetic acid, are well-known preservatives for cosmetic compositions, particularly, those comprise vitamin A. Bisset further teaches that substantially free of formaldehyde or formaldehyde donating compound is essential for the stability of cosmetic composition. See, particularly, column 15, line 1 to column 16, lines 16.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a vitamin A containing cosmetic composition without using parahydroxybenzoic acid ester and formaldehyde donating compounds, and employ O-phenylphenol as a preservative and retinyl propionate as vitamin A compound.

A person of ordinary skill in the art would have been motivated to make a vitamin A containing cosmetic composition without using parahydroxybenzoic acid ester and formaldehyde donating compounds, and employ O-phenylphenol as a preservative and retinyl propionate as vitamin A compound because parahydroxybenzoic acid ester is not required in the vitamin a containing cosmetic composition, and formaldehyde is known to destabilize cosmetic composition. Further, use a preservative in a cosmetic composition, particularly well-known preservative, is obvious because of its known utility. The employment of a particular retinoid, e.g., retinyl propionate, is

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seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388).

(10) Response to Argument

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion and motivation are found both in the cited references and the general knowledge in the art. Particularly, nowhere does Yanagida teach the requirements of the presence of parahydroxybenzoic acid esters, and Bissett et al. teaches that the preservatives herein employed, such as O-phenylphenol, dehydroacetic acid, are well-known preservatives for cosmetic compositions, particularly, those comprise vitamin A. Bissett further teaches that substantially free of formaldehyde or formaldehyde donating compound is essential for the stability of cosmetic composition. Therefore, taking the cited references as a whole, the claimed invention, which employ an old and well-known preservative and not employ

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parahydroxybenzoic acid ester and aldehyde compounds, would have been obvious to one of ordinary skill in the art.

Applicants contend that the claimed invention is not obvious over Yanagida et al. in view of Oblong et al. and Bisset et al. because "none of the cited references recognize or suggest the potential problem of retinoid degradation over time if used in composition containing parahydroxybenzoic acid esters. Further, appellants contend that Yanagida, Oblong, and Bisset et al. all teach away from applicants' invention because all exemplify the use of parahydroxybenzoic acid esters. The examiner disagrees. The instant claims are directed to a composition cosmetic comprising any of the well-known preservatives, but parahydroxybenzoic acid. The discovery of a particular function, i.e., those preservative would not degrade vitamin A would not impart patentable to otherwise obvious utility or composition. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. See *In re Swinehart*, (169 USPQ 226 at 229). Further, question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. *In re Lamberti and Konort* (CCPA), 192 USPQ 278. Not being exemplified does not constitute a teach away. Therefore, employ of o-phenylphenol would have been obvious to one of ordinary skill in the art, particularly, considering the cited prior art as a whole.

In response to applicant's argument that none of the cited references teach that excluding parahydroxybenzoic acid esters, formaldehyde and formaldehyde donating compounds improves retinoid stability, the fact that applicant has recognized another advantage which would

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flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Appellants' arguments that "there is no reasonable expectation of success" deems unpersuasive. The cited references teach vitamin a containing cosmetic composition comprising stabilizer and preservatives. The compositions as suggested by the cited prior art would have been reasonably expected to be stable.

Appellants further contend that the cited references fails to teach or suggest all the claimed limitation. The examiner disagrees. As stated above, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Shengjun Wang

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PRIMARY EXAMINER

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